

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James R. Patterson
Serial No.: 09/747,852
Filed: December 22, 2000
For: Magnetic Plumb Bob Holder

May 19, 2003
Group Art Unit 2859
Examiner: Travis M. Reis

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on January 21, 2003.

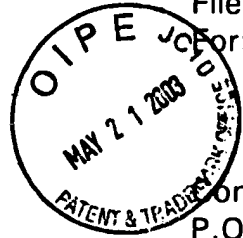
The fees required under 37 C.F.R. 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. 1.92(c)):

- I REAL PARTY INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF THE CLAIMED INVENTION
- VI ISSUES

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VII GROUPING OF CLAIMS

VIII ARGUMENTS

ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 112,
FIRST PARAGRAPH

ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 112,
SECOND PARAGRAPH

ARGUMENT: VIIIC REJECTIONS UNDER 35 U.S.C. 102

ARGUMENT: VIID REJECTIONS UNDER 35 U.S.C. 103

ARGUMENT: VIIIE REJECTIONS OTHER THAN 35 U.S.C. 102,
103 AND 112

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR
DESIRABLE.

The final page of this brief bears the practitioner's signature.

I REAL PARTY IN INTEREST (37 C.F.R. 1.192(c)(1))

The real party in interest in this appeal is the party named in the caption
of this brief.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. 1.192(C)(2))

There are no other appeals or interferences that will directly affect, or be
directly affected by, or have a bearing on the Board's decision in this appeal.

III STATUS OF CLAIMS (37 C.F.R. 1.192(c)(3))

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application as filed are: Claims

1 - 16.

B. STATUS OF THE CLAIMS

1. Claims canceled: Claims 2 - 5.
2. Claims withdrawn from appeal: None
3. Claims pending: Claims 1, 6 - 10, 11 and 12 - 16.
4. Claims allowed: Claims 6 - 10 and 12 - 16.
5. Claims rejected: Claim 1.
6. Claims objected to: Claims 1 and 11.

C. CLAIMS ON APPEAL

The claims on appeal are: Claims 1 and 11.

IV STATUS OF AMENDMENTS (37 C.F.R. 1.192(c))

Applicant's Amendment A of July 5, 2002, in response to the non-final Official Action of March 4, 2002, was entered amending claim 1 and canceling claims 2 - 5. No rejections or objections under 35 USC 112 were entered in the non-final rejection of March 4, 2002.

Applicant's Response B was filed September 27, 2002, subsequent to the Final Rejection of August 30, 2002 and submitted arguments, without any amendment to the claims, in response to new grounds of argument and new grounds of rejection of independent claim 1 raised in the Final Rejection of August 30, 2002. All of claims 6 - 16 were allowed in the Final Rejection of August 30, 2002, without objection.

Subsequently, the Final Rejection of August 30, 2002 was withdrawn and a new Final Rejection was entered October 18, 2002 against independent claim 1 and claim 11 (depending from allowed claim 6). The Final Rejection included new grounds of argument and entered new grounds of rejection under 35 USC 103 against claim 1 and new grounds of objection, under 35 USC 112, second paragraph, against claim 1 and 11. The new grounds of rejection was based on the new application of Walter et al. in view of Lee et al. and entered new arguments based on this newly applied combination of references.

Applicant's Amendment C was filed November 18, 2002 in response to the new grounds of argument and new grounds of rejection and objection raised for the first time in the Final Rejection of October 18, 2002 (directed against claims 1 and 11), including new grounds of objection under 35 USC 112. Applicant's Amendment C made formal amendments to claim 1 in response to the objection to the claim under 35 USC 112. The amendment of Applicant's Amendment C has not been entered.

The Advisory Action of November 27, 2002 refused entry of Applicant's Amendment C stating: The amendments raise new issues that would require further consideration and/or search; The amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

V SUMMARY OF THE CLAIMED INVENTION (37 C.F.R. 1.92(c)(5))

Applicant's invention is a unique tool for gauging the true of installed steel door frames. The tool quickly and easily allows an inspector to gauge the true of a door frame in three dimensional space. That is, the tool gauges the true of the steel door frame in both the X -- Y plane and in the Y -- Z plane.

As disclosed in the specification and drawing, and as claimed in allowed independent claim 6 and its dependent claims (including claim 11) the tool provides structure which allows an inspector to use the tool to make the determination of the true status of an installed steel door frame 54. This structure includes the reference plane defined by the magnetic attachment 40 of the base 12, the flange 18 defining an additional reference plane, and a second flange 20 spaced from and parallel to the flange 18. The flanges 18 and 20, and the cavity between the spaced flanges 18 and 20, provides structure which allows a plumb bob 48 to be stored in the tool, if desired, as claimed in claim 11.

The disclosed structure allows the device to be positioned in a particular gauging relationship to a steel door frame 54, as shown in Figures 5 and 6. When so

positioned, the tool may cooperate with a string plumb bob 48 to quickly provide the information about the true status of the steel door frame 54.

As claimed in claim 1, the disclosed tool is defined in means plus function terms. Claim 1 additionally claims the combination of the tool with a plumb bob 48 and claims the storage of the plumb bob 48 in means plus function terms.

VI ISSUES (37 C.F.R. 1.192(c)(6))

Whether claim 1 is unpatentable under 35 U.S.C. 103 over Walters et al. (U.S. patent No. 5,933,974) in view of Lee et al. (U.S. patent No. 5,426,8600).

Whether claim 1 is informal under 35 U.S.C. 112, second paragraph.

Whether claim 11 (depending from allowed claim 6) is informal under 35 U.S.C. 112, second paragraph.

VII GROUPING OF CLAIMS (37 C.F.R. 1.192(c)(7))

Group 1: Claim 1.

Group 2: Claim 11 (depending from claim 6).

VIIA ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH (35 C.F.R. 1.192(c)(8)(i))

The claims on appeal (Claims 1 and 11) were not rejected under 35 U.S.C. 112, first paragraph, hence there are no issues on appeal under this heading.

VIIIB ARGUMENTS-OBJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH (37 C.F.R. 1.192(c)(8)(ii))

The claims on appeal (Claims 1 and 11) were objected to under 35 U.S.C. 112, second paragraph, hence there are issues on appeal under this heading.

Applicant affirms that the language of claim 1 particularly points out and distinctly claims that which the applicant regards as his invention. It is respectfully submitted that the language of claim 1 is not informal, or even awkward, but the language may be clarified by applicant's proposed Amendment C, which has been submitted under Rule 1.116 (a) and (b).

Applicant affirms that the language of claim 11 particularly points out and distinctly claims that which the applicant regards as his invention. Claim 6, from which claim 11 depends does not recite a plumb bob as a claimed element, nor does claim 11. The claimed device of claim 6 has means to cooperate with a plumb bob, such as the defined reference planes, but does not claim a plumb bob. Claim 11 claims means to store a plumb bob, but does not claim a plumb bob. If "a" in line 1 of claim 11 is changed to -- the --, a faulty antecedent is introduced to the claim since there is no claimed element of a plumb bob in claim 6 to which the antecedent can refer. It is respectfully submitted that claim 6 is formal as written.

VIIIC ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 102 (37 C.F.R. 1.192(c)(8)(iii))

The claims on appeal, claim 1 and 11 were not rejected under 35 U.S.C 102, hence there are no issues under this heading.

VIIID ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 103 (37 C.F.R. 1.192(c)(8)(iv))

The independent claim on appeal (Claims 1) was rejected under 35 U.S.C. 103, hence there are issues on appeal under this heading.

The rejection of claim 1 is based on Walters et al. (U.S. patent No. 5,933,974) in view of Lee et al. (U.S. patent No. 5,426,860). Walters et al. does not disclose or suggest a device that has means for gauging the true condition of a steel door frame in relation to three dimensional space. The Walters et al. reference is silent with regard to this function. The Walters et al. reference shows only a carpenters square and level structure which can only supply information in two

dimensional space. The two spirit levels 12 and 14 of the reference have no cooperation and supply no information in the Y - Z plane. The Examiner has gratuitously added an element d3 on the Walters et al. Figure 1, but this hindsight addition cannot supply the deficiencies of the reference. Rather, the hindsight addition of a gratuitous element underlines the deficiencies of the reference. Further, Walters et al. does not have the claimed element of a means to store a plumb bob.

Lee et al. discloses only a cylindrical case for a plumb bob. Lee et al.'s case has no function other than to store a plumb bob. There is no structure disclosed or suggested which can assess the true status of a door frame. The case is specifically disclosed as being a cylinder, as such, the holder is incapable of being an accurate gauge.

Neither Walters et al. or Lee et al. provide any incentive for combining the carpenter's square and level of Walters et al. and Lee et al.'s cylindrical plumb bob case to produce applicant's claimed device. There is no suggestion of where and how to incorporate the plumb bob case into the Walters et al. structure without destroying the structure and function of the references. The two references teach away from applicant's claimed invention. The only incentive for the radical reconstruction of the two references is provided by applicant's disclosure. A rejection on this basis is impermissible hindsight. See *In re Imperato* 179 USPQ 730 (CCPA 1973).

VIII ARGUMENTS-REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112
(37 C.F.R. 1.192(c)(8)(v))

There are no further issues on appeal.

IX APPENDIX OF CLAIMS (37 C.F.R. 1.192(c)(9))

The text of the claims involved in the appeal are:

1. A tool for inspecting and gauging the accuracy of an installed steel door frame structure, the tool having means for removable attachment to a frame, the attachment means including a magnet, the tool also having means for gauging the condition of the frame in relation to a true status, the gauging means including a plumb bob, the tool having means for storing the plumb bob within the tool, the gauging means including means for assessing the true status of a frame in relation to three dimensional space.

6.(allowed) A tool for inspecting the accuracy of installed steel door frames, the tool having a base with a magnetic attachment therein, the magnet attachment having a terminal portion defining a first reference plane, the tool further having a first flange extending from the base, the first flange having an outer surface defining a second reference plane, the tool having a second flange extending from the base, the second flange being spaced from the first flange and being parallel to the first flange, the second flange having an aperture therethrough, the aperture accepting the string of a plumb bob, the tool cooperating with a plumb bob and string received in the aperture, when attached to an installed steel door, to gauge the accuracy and true of the installed steel door in relation to three dimensional space.

11. The tool of claim 6 wherein the tool includes means for storing a plumb bob and string within the tool.

OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

There are no further materials, that are necessary or desirable, required in consideration of this appeal.

Respectfully submitted,

A handwritten signature in black ink that reads "Edward H Renner". The signature is written in a cursive style with a large, prominent "R".

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